



03 OCT 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PATENT DEPT
EXELIXIS, INC.
170 HARBOR WAY
P.O. BOX 511
SOUTH SAN FRANCISCO, CA 94083-0511

In re Application of	:	
BANNEN, Lynne Canne et al.	:	
Application No.: 10/518,110	:	DECISION
PCT No.: PCT/US03/18262	:	
Int. Filing Date: 11 June 2003	:	ON REQUEST UNDER
Priority Date: 12 June 2002	:	
Attorney's Docket No.: EX02-039C-US	:	37 CFR 1.497(d)
For: HUMAN ADAM-10 INHIBITORS	:	

This decision is in response to "Response to the Notification of Missing Requirements," filed on 15 July 2005. It has been treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 11 June 2003, applicant filed international application PCT/US03/18262, which claimed a priority date of 12 June 2002. The deadline for entry into the national stage in the United States was midnight on 12 December 2004.

On 10 December 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of the inventors.

On 16 June 2005, the Office mailed Notification of Missing Requirements, indicating that the declaration listed an inventor not listed on the international application and requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration.

On 15 July 2005, applicant filed the instant request.

DISCUSSION

Applicants file this request to add Richard George Khoury as an inventor.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1) and (2) have been satisfied. Applicants provided a statement by Richard George Khoury and the processing fee.

Item (3) has not been satisfied. Applicants must supply the consent of the assignee. Applicants have not satisfied 37 CFR 3.73(b). Applicants have not provided the assignment records, nor indicated where the assignment records can be located. Nonetheless, a check of Office records indicates that Exelixis assigned interests in this application to SmithKlineBeecham. If this is correct, the consent of SmithKlineBeecham is required. If there are any other assignees on this application, their consents are also required.

Additionally, the declaration does not comply with 37 CFR 1.497(a)-(b). Applicant has supplied one page 1, one pages 2 and additional inventor sheet. Applicants supplied one each of additional inventor sheets 1 of 4, 2 of 4 and 4 of 4, but three pages 3 of 4. The pages 3 of 4 list the same inventors, but were separately executed. While it is acceptable for inventors to execute different copies of the declaration, applicants must supply the full copy of the declaration executed by each inventor. Applicants may not piece together pages from different declarations to create a composite declaration. It appears there were at least three copies of the declaration executed. Applicants must supply complete declarations in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response including a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration, must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)".

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459